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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/537,176 | 03/29/2000 | Marco Caeran | P18888 | 6098 |
| 7055 | 7590 | 12/23/2003 | EXAMINER | |
| GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191 | | | MOHANDESI, JILA M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3728 | |

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/537,176

Applicant(s)

CAERAN, MARCO

Examiner

Jila M Mohandesi

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-13, 15, 17-20, 24-27, 29, 30 and 33-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-13, 15, 17-20, 24-27, 29, 30 and 33-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 19-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5. Under MPEP 809 and 809.02 (a) there is no requirement to prove whether there is a serious burden on the examiner to examine the species. If applicant's traverse is based upon an admission that the species identified are not patentable distinct, applicant should admit on the record that this is the case.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-12, 15, 17-18, 24-27, 29, 30 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kan (Des. 405,591) in view of Hoshizaki et al. (5,498,033). Kan discloses a sports boot that permits a certain amount of dorsal and plantar flexion, comprising an outer sole and an external upper overlying the outer sole and covering a user's foot and lower leg, said external upper comprising a flexible frame affixed to said external upper and said outer sole, said flexible frame comprising a dorsal portion extending upwardly above an area adapted to cover an ankle of the user, said dorsal portion being adapted to cover a rear of the user's lower leg, and said

flexible frame further comprising at least one elongated lateral portion extending laterally forwardly from said dorsal portion, at least a part of said lateral portion of said flexible frame being spaced above said outer sole, another part of said lateral portion of said flexible frame being connected to said outer sole proximate an area adapted to cover a metatarsophalangeal joint of the user's foot. See Figure 7 embodiment.

Kan is silent about the material of the frame. Hoshizaki '033 discloses a skate boot having an upper including a flexible non-stretchable frame which improves the overall strength and rigidity of the skate boot. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the frame of Kan from flexible non-stretchable material as taught by Hoshizaki '033 in order to improve the overall strength and rigidity of the skate boot.

With respect to claims 10 and 11, Hoshizaki '033 discloses fixing the frame to the external upper by stitching. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to fix the frame of Kan to the external upper as taught by Hoshizaki '033 for a better attachment.

With regard to claim 15, note the lateral arms (7), which are in the form of flat bands.

With regard to claim 17, see Figure 1 embodiment.

With regard to claims 25, 26, 29 and 30 which further limit the material of the flexible frame; it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claim 35, it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

4. Claims 13 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claim 24 and further in view of Bourdeau (5,887,886). Kan as described above discloses all the limitations of the claims except the dorsal portion extending from the outer sole substantially up to a top end of the external upper at about mid-height of a tibia area of the boot and for the flexible frame to at least include a space between said dorsal portion and said other sole. Bourdeau '886 discloses a frame where the dorsal portion extends from the outer sole substantially up to a top end of the external upper at about mid-height of a tibia area of the boot and bearing a wide scallop **44** at the level of the heel which provides a space between the dorsal portion and the outer sole so as to allow the positioning of shock absorbing means at this level, and to allow tactile sensations of the heel (see Figure 2 embodiment). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the dorsal portion of Kan extend from the outer sole substantially up to a top end of the external upper at about mid-height of a tibia area of the boot and bearing a wide scallop at the level of the heel of the flexible frame as taught by Bourdeau '886 so as to allow the positioning of shock absorbing means at this level, and to allow tactile sensations of the heel.

Response to Arguments

5. Applicant's arguments with respect to claims 2-13, 15, 17-20, 24-27, 29, 30 and 33-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M Mohandesi whose telephone number is (703) 305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

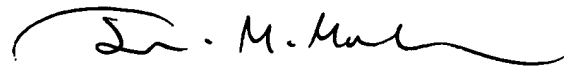
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

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JILA M. MOHANDESI
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "J. M. Mohandesi", with a long horizontal flourish extending to the right.

Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
December 16, 2003